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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: BRUCHMANN ET AL.

CONFIRMATION No.: 8697

SERIAL NO. 09/726,045

GROUP ART UNIT: 1751

FILED: NOVEMBER 30, 2000

EXAMINER: PREETI KUMAR

FOR: BUILDING BLOCKS CONTAINING ISOCYANATE GROUPS AND THEIR  
USE FOR FUNKTIONALIZING OR MODIFYING COMPOUNDS OR SUR-  
FACES

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Date of Deposit	2/17/04
Person Making Deposit	Mary Chadwick
Signature	<i>Mary Chadwick</i>
Date of Signature	2/17/04

Honorable Commissioner

for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY UNDER 37 C.F.R. §1.111

Sir:

In reply to the Office action of December 03, 2003, it is re-  
spectfully requested that the following remarks be entered and con-  
sidered:

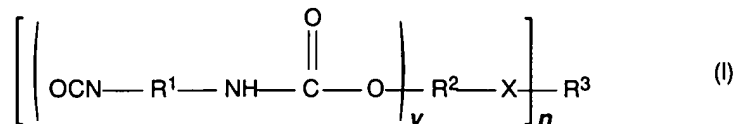
REQUEST FOR RECONSIDERATION

Claims 1 to 13 as submitted upon filing of the application are  
currently pending. Claims 1 to 5, 7, 9 and 10 stand withdrawn from  
consideration, and Claims 6, 8 and 11 to 13 stand rejected.

The Examiner has rejected Claims 6, 8 and 11 to 13 under 35  
U.S.C. §102(e) as being anticipated by the teaching of *Jans n et al.*  
(US 6,080,831). More particularly, the Examiner contends that *Jans n et*  
*al.* disclose a process wherein a compound (designated by Jansen et al. as

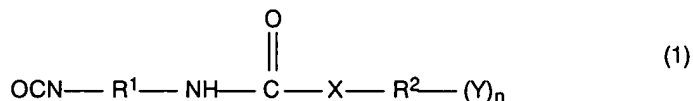
"modified polyisocyanate" and represented by "formula (I)") corresponding to applicants' compound of formula (1) as defined in Claim 6 is employed.

The modified polyisocyanate which is employed in accordance with the disclosure of *Jansen et al.* is represented by the following formula (I)<sup>1)</sup>:



The index "n" is defined by *Jansen et al.* as " $\geq 2$ "<sup>2)</sup> and the compounds of formula (I) disclosed by *Jansen et al.*, therefore, comprise at least two of the bracketed moieties.

The compounds employed in applicants' process are represented by formula (1)



and accordingly contain only one moiety  $\text{OCN}-\text{R}^1-\text{NH}-\text{CO}-\text{X}-\text{R}^2-$ .

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed<sup>3)</sup>, and the test for anticipation is one of identity, the identical invention must be shown in as complete detail as is contained in the claim<sup>4)</sup>. In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning<sup>5)</sup>.

Due to the structural differences between the modified polyisocyanate represented by *Jansen et al.*'s formula (I) and the compound represented by applicants' formula (1), the disclosure of *Jansen et al.* cannot be considered to show subject matter which is identical to applicants' invention as defined in Claim 6 and further specified in Claims 7 to 13. Accordingly, the disclosure of *Jansen et al.* does not amount to a teaching which anticipates applicants' invention within

1) Col. 1, indicated line 44, to col. 2, indicated line 21, of *US 6,080,831*.

2) Col. 2, indicated line 21, of *US 6,080,831*.

3) ie. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (CAFC 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967)

4) ie. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989)

5) ie. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (CAFC 1984)

the meaning of Section 102. It is therefore respectfully requested that the rejection of applicants' Claims 6, 8 and 11 to 13 under 35 U.S.C. §102(e) based on the teaching of *Jansen t al.* be withdrawn. Favorable action is respectfully solicited.

The Examiner additionally rejected Claims 6 and 8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable in light of the subject matter of claim 3 of *US 6,080,831* of *Jansen et al.* The non-statutory obviousness-type double patenting rejection is not deemed appropriate under the circumstances here because the present application and *Jansen et al.*'s patent *US 6,080,831* are not commonly owned.

Moreover, the disclosure of *Jansen et al.* is not deemed to establish a case of obviousness within the meaning of 35 U.S.C. §103(a)<sup>6</sup>). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success, and, finally, the prior art reference must teach or suggest all the claim limitations. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and cannot be based on applicant's disclosure<sup>7</sup>). Accordingly, the mere fact that the prior art can be modified in some manner so as to arrive at a claimed invention does not support a conclusion of obviousness where the prior art fails to suggest the desirability of the specific modification which is necessary<sup>8</sup>).

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6) The determination of obviousness-type double patenting essentially involves a determination of obviousness under 35 U.S.C. §103, with the exception that the patent disclosure is not applicable as "prior art" (*In re Braat*, 937 F.2d 589, 594, 19 USPQ2d 1289, 1293 (CAFC 1991); *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970)). Corresponding to the determination under Section 103, there must be some clear evidence to establish why a person of ordinary skill would make the modification which is necessary to arrive at the claimed invention, and the evidence must be properly qualifiable as "prior art" (*In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (CAFC 1986); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (CAFC 1985), vacated 475 U.S. 809, 229 USPQ 478 (1986), on remand 810 F.2d 1561, 1 USPQ2d 1593 (CAFC), cert. denied 481 U.S. 1052 (1987)). Also, in both determinations, the level of skill in the art alone cannot be relied upon to provide the suggestion to modify the prior art (*In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (CAFC 1986)).

7) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (CAFC 1991)

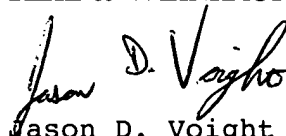
8) ie. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984); see also, eg., *Interconnect. Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985)

The disclosure of *Jansen et al.* fails to teach or suggest all of the limitations which characterize the subject matter of applicants' Claim 6 for failing to teach or suggest the structural particularities which characterize applicants' compounds (1). Additionally, the disclosure of *Jansen et al.* fails to provide for the suggestion or motivation which is necessary for a person of ordinary skill in the art to modify the polyisocyanates (I) of *Jansen et al.* as is necessary to arrive at applicants' formula (1). As such, two of the three basic criteria for establishing a prima facie case of obviousness are not met, and the subject matter of applicants' Claim 6 cannot be considered as being rendered unpatentable under 35 U.S.C. §103(a) by the disclosure of *Jansen et al.* Claims 7 to 13 depend, either directly or indirectly, upon Claim 6 and incorporate the structural particularities which characterize applicants' compounds (1) by reference. The subject matter defined by those claims is, therefore, equally patentable in light of the teaching of *Jansen et al.*<sup>9)</sup>. Favorable action is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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9) If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious (In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (CAFC 1988)).